

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOBUHIRO MIAHIMA,
KAZUHIRO ISHIGURO, and
TOSHIYA SHIRASAWA

Appeal 2007-0480
Application 09/585,339
Technology Center 2600

Decided: April 30, 2007

Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and
HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.
DIXON, *Administrative Patent Judge*.

ORDER

This is an Order to Appellants. From our initial review of the application and prosecution history, we note a number of items and issues that need to be addressed and clarified by Appellants prior to our decision on the merits.

A patent Examiner rejected claims 1, 2, 4-16, and 18-23. Appellants appeal therefrom under 35 U.S.C. § 134(a). We order Appellants to brief a matter that would assist us in deciding their appeal.

At the time of Appellants' Brief, an Appeal Brief was required to include a Summary of the Claimed Invention pursuant to 37 C.F.R. § 41.37(c)(1)(v). The present appeal contains independent claims 1, 8, 11, 15, 20, 21, and 23, but the Summary of the Claimed Invention section of the Brief only discusses independent claim 1 (Br. 3-7). Additionally, the Principal Brief only addresses the merits of independent claim 1, but the Reply Brief sets forth arguments about a range of independent claims beyond independent claim 1.

Therefore, we find that Brief is non-compliant with respect to the Summary of the Claimed Invention. MPEP 1205.02 (Eighth Edition, August 2001; Fourth Revision October 2005) sets forth the requirements for the contents of the Brief. Specifically, the Summary of the Claimed Invention is discussed as follows:

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in *each* of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters. While reference to page and line number of the specification requires somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine

where the claimed subject matter is described in the application. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of 37 CFR 41.37(c)(1)(vii), every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. If appellant does not provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), the Office will notify appellant of the defect in the brief and give appellant a time period within which to file an amended brief. See 37 CFR 41.37(d). [Emphasis added.]

We decline to substitute speculation about where the claimed subject matter is described in the application for the greater certainty that should come from the Appellants in a more specific summary of their claimed invention. Instead, Appellants should read each of the separately argued claims on their specification and drawings. In particular, a mapping of each of the claimed limitations to specific pages and lines of the specification and reference characters of the drawings is needed for a meaningful review.

Under 37 C.F.R. § 41.50(d)(2005), formerly 37 C.F.R. § 1.96(d), the Appellants are given a non-extendable time period of thirty days within which to respond to this order. Failure to comply with the Order within that time may result in the *sua sponte* dismissal of their appeal. 37 C.F.R. § 41.50(d). No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a).

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